

Serial Number: 09/938,465

Docket Number: 10010979-1

### REMARKS

Upon entry of this Response, claims 1-23 remain pending in the present application. Applicant respectfully requests reconsideration of the pending claims in view of the following remarks.

In item 2 of the Office Action, Applicant has been required to furnish formal drawings in response to the Office Action. Applicant respectfully points out that the drawings were formal as filed. Consequently, and in accordance with a telephone conversation between the undersigned and the Examiner, it was deemed that formal drawings need not be submitted at this time in view of the fact that formal drawings have already been submitted in the case. Accordingly, Applicant requests that the formal drawings be approved.

In item 3 of the Office Action, claims 1-23 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent, 5,907,837 issued to Ferrel et al. (hereafter "Ferrel"), U.S. Patent 6,012,071 issued to Krishna et al., (hereafter "Krishna"), and further in view of U.S. Patent Publication No. 2003/0163784 published by Daniel (hereafter "Daniel"). A prima facie case of obviousness is established only when the prior art teaches or suggests all of the elements of the claims. MPEP §2143.03, In re Rijckaert, 9 F.3d 1531, 28 U.S.P.Q2d 1955, 1956 (Fed. Cir. 1993). Applicant respectfully asserts that the cited combination of references fails to show or suggest each of the elements of claims 1-23 as originally filed. Accordingly, Applicant requests that the rejection of claims 1-23 be withdrawn for the reasons that follow.

To begin, claim 1 as originally filed recites as follows:

1. A method for tracking a placement of a content element in a publication, comprising:
  - detecting at least one placement tag associated with the content element in a computer system, the content element comprising at least a portion of a content item to be placed in the publication;
  - determining at least one position in the publication at which the content element is placed when the at least one placement tag is detected; and
  - generating a placement report that logs the at least one position of the content element within the publication.

With respect to claim 1 above, the Office Action states that:

"Ferrel does not explicitly disclose the use of "determining at least one position in the publication at which the content element is placed when the at least one placement tag is detected". Krishna discloses an

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analogous electronic publishing system that employs servers to store electronic publication. In particular, Krishna discloses the claimed "determining at least one position in the publication at which the content element is placed when the at least one placement tag is detected". (col. 10, lines 61-67; col. 11, lines 1-9). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teaching of the cited references." (Office Action, pages 2-3)

Applicant respectfully disagrees. Specifically, claim 1 provides for determining the position in the publication at which a content element is placed when the placement tag associated with such content element is detected. In the excerpt at column 10, line 61 through column 11, line 9, Krishna states:

"The server stores a publication outline file, the publication outline file defining a layout of the electronic publication such that the electronic publication contains at least one regions, and for each region, the publication outlined file containing formatting instructions for how to format information displayed within each region, the formatting instructions including at least a name of a font file containing fonts to be used in displaying text context information within the corresponding region, as well as locating instructions for how to locate content information for each respective region, a content information being stored in a file separately from the formatting instructions and a content file different from the publication outline file, and upon request from the client, the server sends the publication outline file to the client..."

As described above, Krishna describes the placement of content items in a region associated with a publication. However, Krishna fails to show or suggest determining a position in the publication at which a ***content element has already been placed when the at least one placement tag is detected that is associated with the content element*** as set forth in claim 1. In this respect, claim 1 provides for a method in which the placement of various content elements such as articles in a given publication is detected so that the relative placement of the content item in the publication can be known for purposes of calculating a charge for such placement. In this respect, Krishna fails to even determine the position at which a content item has already been placed in response to detection of a placement tag associated with the content element. Accordingly, Applicant asserts that the cited combination of references fails to show or suggest each of the elements of claim 1 for this reason.

In addition, the Office Action further states:

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"Neither Ferrel or Krishna discloses the use of generating a placement report that logs the at least one position of the content element within the publication. On the other hand, Daniel discloses the claimed "generating a placement report that logs the at least one position of the content element within the publication" (page 8, paragraph [0078]). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teaching of the cited references."

Applicant respectfully disagrees. Specifically, at page 8, paragraph [0078]

Daniel states:

"While it is possible, of course, to install both the database serving and the web serving software on the same physical device, generally it is recommended that a separate machine from the web server 306a be disused as a database server 207a as depicted in order to optimize performance. In addition to a web server 306a and a database server 307b as shown in FIG. 3, other servers may be needed in alternative embodiments depending upon the nature of the content being compiled with the administration tool. For example, a reporting system could use a crystal reports web server or other dedicated reporting server to enable generation and delivery of administrative reports in view of the web. In such embodiments, the reporting web server would need to be installed in the server system 306. Additionally, depending on the nature of the instructional or informational materials present in the objects, streaming media servers may be needed in order to fully use the preview functions of the system. For example, full support for the use of real audio and real video or other like streaming media content within objects would require the addition of a suitable streaming media server within the central network 301."

Daniel merely discusses the generation and delivery of "administrative reports" via the Internet. The generalized discussion of generating "administrative reports" does not show or suggest the concept of generating a placement report that logs the at least one position of the content element within a given publication. In this respect, the generation of the placement report and storage of such report in an appropriate location allows for a publisher of a publication to determine pricing with which to charge advertisers for the placement of their advertisements, for example, based upon the position of the advertisement within the publication. For example, an advertisement that appears near the front page of a publication might be more expensive than advertisements that appear in the later pages of a publication, given the lesser amount of user scrutiny of such later pages as opposed to the front pages of a publication.

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Accordingly, Applicant asserts that the rejection of claim 1 in view of the cited references is improper. Therefore, Applicant requests that the rejection of claim 1 be withdrawn. In addition, Applicant requests that the rejection of claims 8, 15, 22, and 23 be withdrawn for the reasons described above. In addition, Applicant requests that the rejection of claims 2-7, 9-14, and 16-21 be withdrawn as depending from claims 1, 8, and 15, respectively.

In addition, claims 3 and 4 recite as follows:

3. The method of claim 1, wherein the step of generating the placement report that logs the at least one position of the content element within the publication further comprises:

identifying a placement report identifier associated with the at least one placement tag; and  
writing the placement report identifier to the placement report.

4. The method of claim 1, wherein:

the step of determining the at least one position in the publication at which the content element is placed when the at least one placement tag is detected further comprises determining the at least one position of the content element in terms of a set of rectangular coordinates and an area; and

the step of generating the placement report that logs the at least one position of the content element within the publication further comprises:

generating a blank placement report in a memory;  
and  
writing the set of rectangular coordinates and the area to the blank placement report.

With respect to claims 3 and 4, the Office Action states:

"Daniel discloses the claimed "identifying a placement report identifier associated with the at least one placement tag" and "writing the placement report identifier to the placement report" (page 8, paragraph [0078])." (Office Action, page 4)

Applicant respectfully disagrees. Specifically, Daniel fails to show or suggest anything related to identifying a placement report identifier associated with a placement tag that is in turn associated with a content element and writing such placement report identifier to a placement report. Specifically, the generalized discussion of "administrative reports" does not rise to the level of showing or suggesting the specific elements of claims 3 and 4. Accordingly, Applicant requests that the rejection of claims 3 and 4 be withdrawn for this additional reason. In

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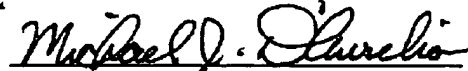
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addition, Applicant respectfully requests that the rejection of claims 10, 11, 17, and 18 be withdrawn for the above additional reasons as well.

**CONCLUSION**

Applicants respectfully request that all outstanding objections and rejections be withdrawn and that this application and all presently pending claims be allowed to issue. If the Examiner has any questions or comments regarding Applicants' response, the Examiner is encouraged to telephone Applicants' undersigned counsel.

Respectfully submitted,



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